



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,678	08/20/1999	MARY K. MCCARTY	1002JJ-35352	9419

7590 10/17/2002

Pillsbury Madison & Sutro LLP
Intellectual Property Group
1100 New York Avenue, NW
Ninth Floor
Washington, DC 20005-3918

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/378,678

Applicant(s)

MCCARTY ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

Claims 1-39 are pending in the Applicant's response filed on 02 July 2002.

None of the original claims, Claims 1-29, were amended.

Response to Arguments

Applicant's arguments with respect to Claims 1-29 have been considered but are moot in view of the new ground(s) of rejection. The Declaration was effective in overcoming Dodd, patent number 6,321,211 which was removed as cited prior art in this non-final action.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3625

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 7, 10, 11, 16-20, 25-27, and 29 are rejected under 35 USC 102(b) as being anticipated by Small, patent number 5,513,117.

Small teaches all the limitations of Claims 1-3, 6, 7, 10, 11, 16-20, 25-27, and 29. For example, Small discloses a system and method for designing personalized greeting cards, selecting gifts and gift amounts from a menu, and printing and mailing the personalized greeting card and gift. Remote customers using personal computers connect to the greeting card and gift central computer via the public telephone network to preview gift card designs, select a card design for a recipient, select a gift certificate from a number of participating listed merchants, optionally personalize the combined card and gift with graphics and text, have it printed and mailed to the recipients physical address or have it electronically mailed to the recipient, and pay electronically with a credit card (please see abstract; Fig. 4 (50, 51, 54, 64); col. 1, line 15 through col. 3, line 59; col. 5, lines 35-45; col. 6, lines 6-12). Small teaches a greeting card and gift selection combination that is printed on perforated card stock to allow easy separation of the gift certificate or pre-paid phone card from the greeting card (see at least Fig. 10 (173); Fig. 11 (180, 181); col. 7, lines 36-46). Small further teaches the customer providing recipient information to the central computer, viewing a list of occasion categories and selecting from a variety of pre-designed

Art Unit: 3625

greeting cards with sentiments, or customizing a greeting card with a sentiment (see at least col. 7, lines 1-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 4, 5, and 30-32 are rejected under 35 USC 103(a) as being unpatentable over Small, patent number 5,513,117 in view of Borders.com (collection of articles cited in PTO-892 Items: U-X; page 2 Item: U).**

Small teaches all the above as noted under the 102(b) rejection and further teaches listing a number of participating national merchants from which to choose a gift certificate and dollar amount. Borders.com teaches an online retail outlet for buying gift certificates and further teaches web links to retail store locations organized by state, locality within each state, and hours of operation. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small to list locations of national merchant as taught by Borders.com, in order to achieve customer and recipient convenience objectives and thereby retain existing customers and attract recipients to the site as potential new customers.

4. Claims 8,9, and 12-15 are rejected under 35 USC 103(a) as being unpatentable over Small, patent number 5,513,117, in view of PR Newswire (PTO-892 page 2 Item: V)

Small teaches all the above as noted under the 102(b) rejection and further teaches listing national merchants, prompting the buyer to make a combined greeting card and gift selection, a buyer entering gift amount information and recipient information, but does not disclose ordering for multiple recipients. PR Newswire teaches online gift giving through Nordstrom's website at www.nordstrom.com. Built-in conveniences for customers include a multiple shipping feature that allows customers to ship their orders to different addresses across the country in a single order. Gift orders can be boxed and shipped directly to multiple recipients (\$4.00 per gift boxes) or a customer may choose to receive their gift purchases with complimentary flat gift boxes to make personal deliveries (see page 1). PR Newswire further teaches a) customers using the online locator to find stores by state or zip code to get map directions to store locations within the selected state, b) customers registering on the site and using a personal address book to record addresses and phone numbers of friends and family, and c) taking advantage of the gift reminder service to set up personal email reminders for themselves for special dates and occasions. PR Newswire teaches registered customers accessing a complete history of their previous online purchases at any time (see pages 1-2). Therefore it would have been

obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small to incorporate ordering for multiple recipients at different addresses as taught by PR Newswire, in order to accommodate group ordering of a greeting card and gift combination, and thereby further provide the buyer with additional purchasing conveniences.

5. Claims 21-24, 33-39 are rejected under 35 USC 103(a) as being unpatentable over Small.

Small teaches all the above as noted under the 102(b) rejection and further teaches printing the name and address of the recipient and the sender on the card, and printing a combined card on both sides of a single sheet (see at least Fig. 11 (180, 181); col. 6, lines 42-46). This examiner takes the position it would be a prudent business practice to meet privacy expectations as compared to a greeting card and gift certificated enclosed in an envelope, and thereby not simply mail the card with sentiment and gift value and other identifying information exposed due to a lack of a step in folding the card before it is mailed. This examiner further takes the position that all mailing information noted above would be printed on the opposite side of either Fig. 11 (180) or Fig. 11 (181) so that when the card is folded to conceal sentiment privacy, gift values, and PIN number, the address information would be on the outside of the folded card for postal authority use. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small to

Art Unit: 3625

include card folding as noted above, in order to maintain equivalent expectations of privacy as compared with an envelope-enclosed card and gift certificate.

6. Claim 28 is rejected under 35 USC 103(a) as being unpatentable over Small, in view of Christensen et al, patent number 5,710,886.

Small teaches all the above as noted under the 102(b) rejection and further teaches prepaid gifts, money orders, or virtually any gift which can be evidenced by an electronically generated personalized printout, and further teaches retail sales outlets selling gifts in combination with purchased greeting cards, but does not disclose coupons as a form of gift-giving. Christensen et al teaches an electronic method of distributing, generating, and redeeming discount coupons, rebate certificates, or gift certificates. As prior art, Christensen et al teaches discount coupons as being an integral part of marketing strategies for many retail consumer goods, and further teaches product manufacturers relying upon coupons, rebates, and gift certificates to promote new and existing products, to boost sales, and to obtain demographic information concerning consumer buying patterns. Therefore it would have been obvious to modify the system and method of Small to include coupons as taught by Christensen et al, in order to offer additional incentives provided by manufacturers associated with the retail site.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

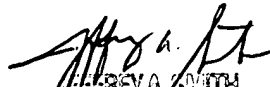
Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
September 23, 2002


E. PREVA SMITH
PRIMARY EXAMINER